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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| Proceeding                | 92052897  |
|---------------------------|---|
| Party                     | Defendant Galderma Laboratories, Inc.   |
| Correspondence<br>Address | JEFFREY M BECKER HAYNES AND BOONE LLP 2323 VICTORY AVENUE, SUITE 700 DALLAS, TX 75219 UNITED STATES jeff.becker@haynesboone.com, Lisa.Congleton@haynesboone.com |
| Submission                | Reply in Support of Motion  |
| Filer's Name              | Jeffrey M. Becker   |
| Filer's e-mail            | jeff.becker@haynesboone.com   |
| Signature                 | /Jeffrey M. Becker/   |
| Date                      | 03/31/2015  |
| Attachments               | RESTORADERM Reply in Support of Motion to Resume.pdf(196514 bytes)  |

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Thomas Sköld

Petitioner,

v.

*<u>aaaaaaaaaaaa</u>* 

Cancellation No.: 92052897

Mark: RESTORADERM

Galderma Laboratories, Inc.

Registrant.

Reg. Nos.: 2,985,751 and 3,394,514

#### REPLY IN SUPPORT OF REGISTRANT'S MOTION TO RESUME PROCEEDINGS

Registrant, Galderma Laboratories, Inc., hereby submits this Reply in support of its March 16, 2015 Motion to Resume Proceedings. Notably, the Board may simply treat Registrant's Motion as conceded, since even though Petitioner has filed a Brief in Response, it was only to inform that Board that Petitioner "takes no position on the merits of this pending motion" and to acknowledge that Petitioner never actually moved or sought to seek suspension.

Moreover, the Supreme Court has now recognized that the Board's ruling in this case may result in issue preclusion in the civil action Petitioner filed. B&B Hardware, Inc. v. Hargis industries, Inc. DBA Sealtite Building Fasteners et al., 757 U.S. \_\_\_ (2015) (slip op.). The Board's exercise of its discretionary power to suspend an action pending the outcome of an action in federal court had been based on the -- now inapplicable -- reasoning that "the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." TMBP § 510.02(a); see also New Orleans Louisiana Saints LLC v. Who Dat? Inc., 90 U.S.P.O.2d 1550, 1552 (TTAB 2011) (noting that while a district court decision may be binding on the Board, the Board's determination of a party's right to maintain a registration is not binding or res judicata in federal court). Now that the importance and binding impact of Board decisions have been recognized by the Supreme Court, the Board should resume the current proceeding to provide the district court presiding over Petitioner's civil action with the benefit of the Board's judgment.

The only steps remaining in this proceeding are the Petitioner-requested oral hearing and a decision from the Board, something that both parties have been working toward for nearly five years. As in *B&B Hardware*, the parties here have fully litigated this matter before the Board, and taken extensive discovery complete with multiple depositions. *See B&B Hardware v. Hargis*, 575 U.S. \_\_\_\_, \_\_\_ (2015) (slip op., at 6-7). The Board should resume this proceeding and render its decision, which may be binding upon the district court, especially as trial has already concluded before the Board and the civil action is in its infancy.

For the foregoing reasons, Registrant requests that the Board grant its Motion to Resume Proceedings.

Respectfully submitted,

Jeffrey M. Becker, Esq. Richard D. Rochford, Esq. Attorneys for Registrant

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#### CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 31st day of March 2015, the foregoing *Reply in Support of Registrant's Motion to Resume Proceedings* was served on Petitioner's counsel of record, via email to the following:

Arthur E. Jackson Moser IP Law Group ajackson@mtiplaw.com docketing@mtiplaw.com

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Jeffrey M. Becker